

o/0490/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003788533

BY SIRE SPIRITS LLC

TO REGISTER THE TRADE MARK:

**BRANSON**

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002595

BY ETISE SAMPSON

AND

IN THE MATTER OF UK TRADE MARK REGISTRATION NO. UK00003091084

IN THE NAME OF ETISE SAMPSON

FOR THE TRADE MARK:

**Young Branson**

IN CLASSES 25 AND 35

AND

THE APPLICATION FOR REVOCATION THEREOF

UNDER NO. 505513

BY SIRE SPIRITS LLC

## BACKGROUND AND PLEADINGS

1. On 16 May 2022, SIRE SPIRITS LLC (“SIRE”) applied to register the **BRANSON** trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 15 July 2022. The applicant seeks registration for the following goods:

Class 25      Clothing.

2. The application was opposed by Etise Sampson (“Sampson”) on 14 October 2022. The opposition is based upon sections 5(2)(a) and 5(2)(b) of the Trade Marks Act (“the Act”), and the opponent relies upon the following mark:

# Young Branson

UK registration no. UK00003091084

Filing date 26 January 2015.

Registration date 1 May 2015.

Relying upon some of the goods for which its mark is registered, namely:

Class 25      Clothing.

3. Sampson claims that the marks and goods are identical or similar, and SIRE filed a counterstatement denying the claims made, putting Sampson to proof of use.

4. On 27 October 2022, SIRE sought revocation of Sampson’s mark on the grounds of non-use. Under section 46(1)(a) of the Act, SIRE claims non-use in the five year period following the date on which the mark was registered, i.e. 2 May 2015 to 1 May 2020, claiming an effective date of revocation of 2 May 2020.

5. Under section 46(1)(b), SIRE claims non-use of the **Young Branson** mark for the period of 27 October 2017 to 26 October 2022, claiming an effective date of revocation of 27 October 2022.

6. Revocation under both 46(1)(a) and (b) is sought for all of Sampson's class 25 goods and class 35 services, set out in Annex 1 to this decision.

7. On 3 February 2023, Sampson filed a counterstatement which contained evidence, defending his registration for all the goods and services for which it is registered, on the basis that he has actively used and been trading throughout the relevant periods. Alongside this, Sampson filed evidence in the form of a witness statement dated 3 February 2023.

8. On 3 March 2023, the Tribunal wrote to the parties informing them of the consolidation of the revocation action no. 505513 and the opposition no. 600002595. I also note that at the bottom of the official letter, it states the following:

**“Evidence that has already been filed:**

**We are unable to accept the evidence filed 3<sup>rd</sup> February 2023 as it has not been filed in the correct format and Exhibit 3 has been omitted.”**

9. Therefore, the evidence which is accepted into the proceedings is the evidence Sampson included within his Form TM7F, and SIRE's evidence in chief and submissions that were filed during the evidence rounds. I also note that the above letter gave Sampson the opportunity to file evidence during the evidence rounds, however, none was filed.

10. SIRE is represented by Lewis Silkin LLP and Sampson is unrepresented. I note that neither party requested a hearing, nor filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

## **RELEVANCE OF EU LAW**

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **EVIDENCE**

12. SIRE filed evidence in the form of a witness statement of Erika Coccia dated 14 August 2023. Ms Coccia is a Senior Trade Mark Attorney at Lewis Silkin LLP. Ms Coccia's statement was accompanied by 25 exhibits (EC1-EC25).

13. Whilst I do not propose to summarise the evidence and submissions here, I have taken them into consideration and will refer to them below where necessary.

## **DECISION**

### **The Revocation**

14. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

15. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, **it is for the proprietor to show what use has been made of it.**” (My emphasis)

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. I note the following from Mr Sampson’s evidence which was included within his Form TM7F:

a) The following figures were provided in Q7 which asks the party to provide the number of sales achieved under the mark in the UK:

2019 – 2020 - £1,000

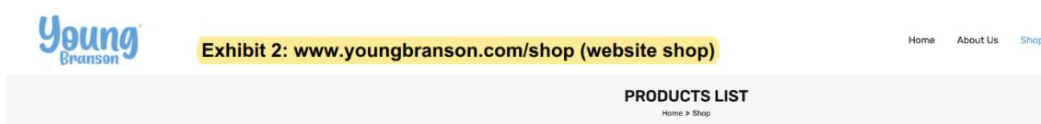
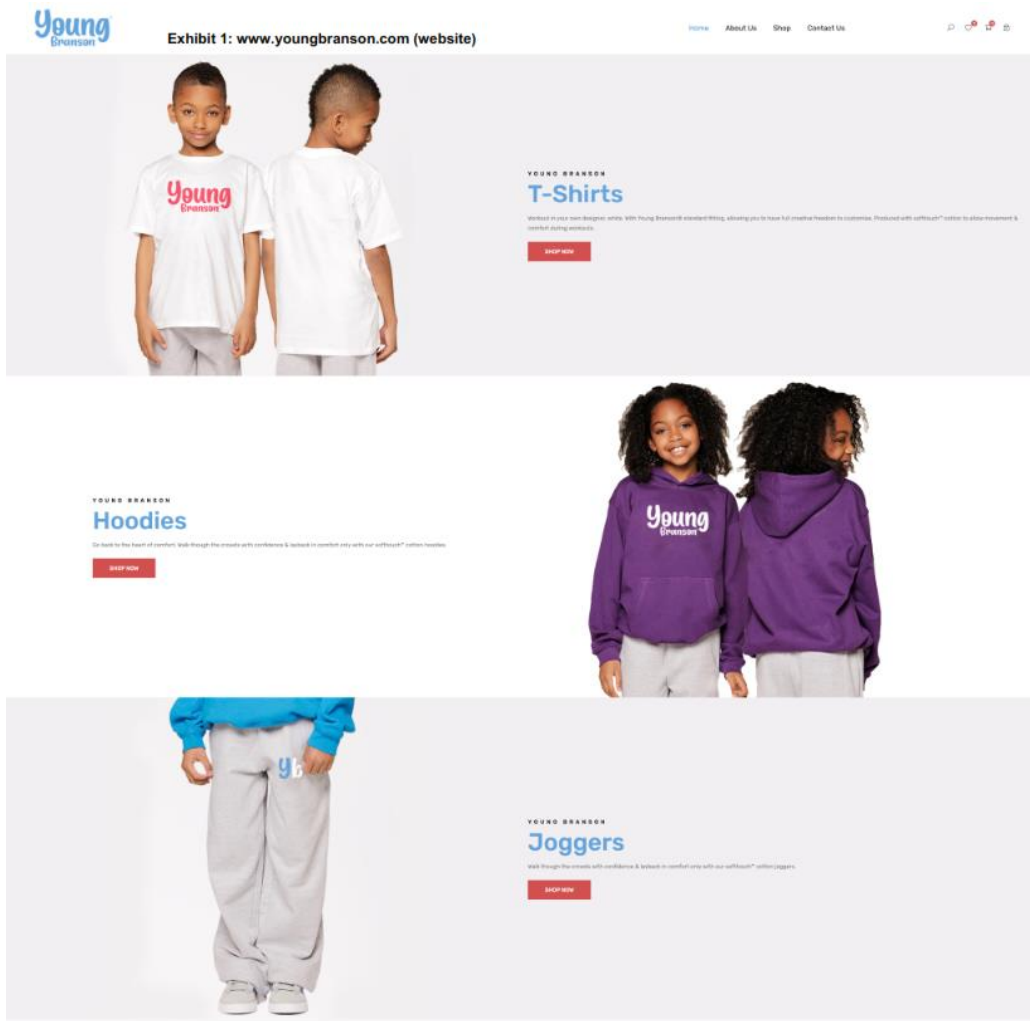
2020 – 2021 - £3,600.00

2021 – 2022 - £2,500

b) At Q9, Sampson provides the following information:

*“Young Branson ‘trademark’ is licenced to various companies for the sell of clothing and merchandise i.e. Bright Red Box (You Got Deal) and NJA Creative (www.youngbranson.com) and I collect royalties for the trade mark licence use, please see licence agreement”.* [sic]

c) **Exhibit 1** and **exhibit 2** contain the following undated screenshots of NJA Creative’s [www.youngbranson.com](http://www.youngbranson.com) website. I note that **exhibit 2** specifically shows the price and types of clothing goods for sale, as follows:



d) **Exhibit 3** contains the following undated screenshots of Young Branson kids t-shirts for sale for £10.99, and a Young Branson kids hoodie for sale for £20.00 on the website [www.yougotdeal.co.uk](http://www.yougotdeal.co.uk):



Young Branson  
Young Branson t-shirt for kids blue

Availability: **Out of stock**

♥ Add to wishlist   ⚖ Compare

Young Branson t-shirt for kids blue

**£10.99** ~~£15.00~~



Young Branson  
Young Branson T-shirt for kids Pink

♥ Add to wishlist   ⚖ Compare

Young Branson t-shirt for kids Pink

**£10.99** ~~£15.00~~

1

🛒 Add to basket



Young Branson  
Young Branson Hoodie for Kids

♥ Add to wishlist   ⚖ Compare

Hoodie for kids

**£20.00** ~~£25.00~~

1

🛒 Add to basket

- e) **Exhibit 5** contains a Trademark Licence Agreement between Mr Etise Sampson “T/A 2020 Effect” and “NJA Creative Limited” “to sell Young Branson clothing” which is dated 21 March 2019.
- f) **Exhibit 6** contains a Trademark Licence Agreement between Mr Etise Sampson “T/A 2020 Effect” and Bright Red Box Limited dated 7 October 2018.
- g) **Exhibit 7** contains an invoice from “Etise Sampson T/A 2020 Effect” to NJA Creative Limited dated 1 January 2020. The invoice is for “Young Branson Trade Mark Usage & Royalty” and the invoice amounts to £1,000.00.

## Assessment of genuine use

18. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered; with the words “Young Branson” appearing on Sampson’s licensee’s website and t-shirts. For the sake of completeness, I note that the words “Young Branson” also appears in slightly stylised typeface. However, the stylisation is very minimal and does not alter the distinctive character of the mark.<sup>1</sup> Therefore, I am satisfied that the mark has been used as registered.

19. I will now consider the global assessment of genuine use. The assessment is made by looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>2</sup> As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

20. As noted above, the onus is also on Sampson to provide sufficiently solid evidence to counter the application that he has not used the mark within the 2 five year periods 2 May 2015 to 1 May 2020 and 27 October 2017 to 26 October 2022.<sup>3</sup> In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use ... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. **A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly**

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<sup>1</sup> *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

<sup>2</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

<sup>3</sup> See *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14).

**demonstrated, the material actually provided is inconclusive.** By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, **the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken,** having regard to the interests of the proprietor, the opponent and, it should be said, the public". (My emphasis).

21. The case law summarised in the passage from *easygroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

22. Where proof of use is required, it is typical to see evidence of turnover figures during the relevant periods. At Q7 of its Form TM7F, Sampson has provided 3 sets of figures, which is supported by the information contained in Q9 which states that Sampsons mark is "licenced to various companies" for the sale of "clothing and merchandise" and that they collect royalties for this use. Moreover, the evidence provided above are screenshots from its licensee's websites and evidence of its licence agreements. I do not have any evidence or submissions from Sampson that it sells its goods directly through its own shop or website, and on this basis, I consider that the figures provided at Q7 are likely to be its royalty payments/licence fees.

23. I therefore do not have any turnover figures for the relevant period, or a breakdown of sales by the types of clothing goods sold. I note that the only evidence I have in relation to clothing is use of the mark on its licensee's t-shirts, hoodies and joggers, and I do not have any evidence as to how many units of each of these goods were sold. Furthermore, I also consider that the above licence figures, (including the licence/royalty invoice referred to at paragraph 17(g)), are relatively low.

24. I note that the evidence does at least show that use of the mark has occurred in the UK, with yougotdeal.co.uk being a UK based website, and both licence agreements confirming that the territory is for the UK (under 1.1 of the agreed terms). However, I have not been provided with any invoices showing the sale of goods to customers, whether retail or wholesale or advertising figures. Therefore, whilst I am able to determine that the customers of the goods are located in the UK, I am still unable to determine the geographical spread of the mark within the UK itself.

25. *The above is all plainly information which should have been available and relatively easy to provide.* However, it is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by Sampson is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, there is no evidence of other activity in this case. Therefore, taking the evidence as a whole into account, I consider that it fails to show real commercial exploitation of the mark to create or maintain a share of the UK market for Sampson's class 25 "clothing" goods or its class 35 retail services for clothing.

26. For the sake of completeness, if I am wrong in finding that the numbers provided at Q7 are royalty payments or licence fees, and they are in fact turnover figures, nothing turns on this. If they are yearly sales figures, they are very low considering that the clothing market is significant, and is highly saturated, in the UK. The evidence also suffers the same deficiencies as outlined in paragraphs 23 and 24 above. The turnover is not broken down into the types of clothing sold, and Sampson has not specified what class 25 goods the sales figures relate to. There is consequently no way in determining how many units of each class 25 goods were sold, and which of those sales relate to t-shirts, hoodies and joggers. On this basis, I still do not consider

that there has been genuine use of the Young Branson mark for Sampson's class 25 and class 35 clothing goods and services.

27. Lastly, I note that Sampson's remaining class 35 services, which he has defended in his counterstatement, are as follows:

*Retail services including retail services conducted from physical premises and online retail services or mail order retail services connected with the sale of CD's, DVD's and other apparatus for the recording of sound or images, paper products, printed matter, photographs, instruction manuals, books, journals, periodicals and magazines, footwear and headgear, sporting and gymnastic equipment, games and playthings; advertising; business management; business administration; office functions; organization, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information.*

28. Whilst the licence agreements list these services within Schedule 1 (which contains the marks specification), there is no other specific mention of the above services within the agreement. It simply defines "services" as "any and all services provided in the course of or relating to the operation of the Business", and nothing further.

29. Moreover, Sampson states in Q9 of their Form TM7F that its mark is "licenced to various companies" for the sale of "clothing and merchandise". The above services are not mentioned, and, therefore, taking all of the above into account, I do not consider that this evidence shows any use of the mark on the above class 35 services.

## **CONCLUSION**

### **The Revocation**

30. The application for revocation on the grounds of non-use therefore succeeds under section 46(1)(a) and 46(1)(b). Sampson's UK00003091084 registration will be revoked

in respect of all goods and services for which it is registered. The effective date (and earliest date) of revocation is **2 May 2020**.

## **The Opposition**

31. As explained in paragraph 1 of this decision, the deemed filing date of SIRE's mark is 16 May 2022. This date is 14 days after the date from which Sampson's UK00003091084 registration is revoked. Therefore, Sampson's mark cannot be relied upon as it no longer exists on the register from 2 May 2020. Sampson no longer has an earlier mark to rely upon in these proceedings, and as such, the grounds of opposition under section 5(2)(a) and 5(2)(b) fall away.

32. The application no. UK00003788533 can proceed to registration in respect of all its goods.

## **COSTS**

33. SIRE has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award SIRE the sum of **£1,550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of Opposition and preparing a Counterstatement	£200
Preparing application for revocation and considering the other side's statement	£200
Preparing and considering evidence	£600
Preparing and filing written submissions	£350
Official fee for filing Revocation	£200

**Total**

**£1,550**

34. I therefore order Etise Sampson to pay SIRE SPIRITS LLC the sum of £1,550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 29<sup>th</sup> day of May 2024**

**L FAYTER**

**For the Registrar**

## **ANNEX 1**

### **Young Branson Mark**

#### Class 25

Clothing, Headwear, footwear.

#### Class 35

Retail services including retail services conducted from physical premises and online retail services or mail order retail services connected with the sale of CD's, DVD's and other apparatus for the recording of sound or images, paper products, printed matter, photographs, instruction manuals, books, journals, periodicals and magazines, clothing, footwear and headgear, sporting and gymnastic equipment, games and playthings; advertising; business management; business administration; office functions; organization, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; provision of business information.